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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,503	12/20/2001	Hiromi Honda	2922.0070	2845

5514 7590 09/24/2003

FITZPATRICK CELLA HARPER & SCINTO  
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NEW YORK, NY 10112

EXAMINER
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LAM, CATHY FONG FONG

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 09/24/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/022,503

Applicant(s)

HONDA ET AL.

Examiner

Cathy Lam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on August 18<sup>th</sup> 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

In view of the Preliminary Amendment filed on August 18<sup>th</sup> 2003, the pending claims are continued to be unpatentable as following:

***Claim Rejections - 35 USC § 112***

1. Claims 1 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is structurally indefinite, lines 7-9 is unclear as to whether or not “an inner peripheral surface” is plated with a conductive material? Furthermore, applicant has not clearly shown where on the printed wiring board the “connection state maintaining means” is formed and not formed? Clarification is required.

Claim 8 is structurally indefinite, as applicant is suggested to change “of the inserted component” to – into said through-holes of said printed wiring board --.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-5 and 7-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by O’Keele (US 3610811).

O’Keele discloses a printed circuit board comprised of a plurality of conductive plated through holes and conductive pads (50,52) on the rim of the through holes.

Conductive wiring patterns (20,22,24) are formed onto the surfaces of an insulating

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panel(18) and are in electrical contact with periphery of the conductive plated through holes (col 3 L 50-56).

A solder resist material (14) is covering at least a portion of the circuit board surface along the perimeter of each plated through hole (or conductive pads) (col 2 L 45-50 & Fig. 4).

The solder resist can be put down onto the entire surface perimeter of the plated through holes (col 2 L 63-66). The solder resist can be applied by silk screen technique (col 4 L 43-45). Component leads (62) are inserted into the plated through holes followed with a solder flux applied into the plated through holes (col 4 L 69-71).

O'Keele also mentioned that oxidizing the conductive surface (or pad) is another way to prevent solder bridging (col 2 L 4-7).

Regarding to the limitation of silk screen pattern, Applicant is reminded that it is the product itself which must be new and unobvious, see *In re Pinkington* 162 USPQ 145, 147 (C.C.P.A. 1969). Product by process claimed are not patentably distinct over product claims unless it can be shown that the product produced by the process is in some manner measurably distinct from the product produced by another process, therefore there will be no weight given to the product by process verses product claims.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Keele (US 3610811) in view of Sarkhel et al (US 5730932).

O'Keele discloses the present invention but silent about using a lead free solder in the through holes

Sarkhel discloses a solder alloy which is used for bonding a component lead to a printed wiring board. The solder alloy is a lead free solder comprised of bismuth (col 2 L 54-56).

In view of O'Keele and Sarkhel's teachings, one skill in the art would choose a lead free solder that includes bismuth for bonding because it forms a chemically and thermally stable bond (see Sarkhel col 2 L 45-50).

Regarding to having both solder resist and a silk screen pattern laminated to the lands of the printed wiring board. Since applicant has not specifically pointed out any advantages or criticalities of using two layers, the examiner takes the position that the prior art teaching of using only one layer would perform the same job as well.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cathy Lam whose telephone number is (703) 308-2418. The examiner can normally be reached on 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (703) 308-3822. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9604 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read "Cathy Lam", with a stylized flourish at the end.

Cathy Lam  
Primary Examiner  
Art Unit 1775

cfl  
September 20, 2003